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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,580	04/15/2004	Anja Kohlrusch	01-1491	8666
28501	7590	08/18/2010		
MICHAEL P. MORRIS				
BOEHRINGER INGELHEIM USA CORPORATION				
900 RIDGEBURY ROAD				
P. O. BOX 368				
RIDGEFIELD, CT 06877-0368				
EXAMINER				
FINN, MEGHAN R				
ART UNIT		PAPER NUMBER		
1614				
NOTIFICATION DATE		DELIVERY MODE		
08/18/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO.e-Office.rdg@boehringer-ingelheim.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/825,580

Applicant(s)

KOHLRAUSCH, ANJA

Examiner

MEGHAN FINN

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 30 July 2010. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,4,5,9 and 12-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Meghan Finn/
Examiner, AU 1614

/James D Anderson/
Primary Examiner, Art Unit 1614

Continuation of 5. Applicant's reply has overcome the following rejection(s): Applicant's reply has overcome the 103 rejection over Lacourciere in view of Donsbach et al. because applicant submitted a statement that both applications were owned by the same entity, C.H. Boehringer Sohn AG & Co. KG.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's request for reconsideration of the present application with regard to the rejections of double patenting and the rejection under 35 U.S.C. 103(a) over Haul et al. in view of Dinnebie et al. in further view of Vippagunta et al. Applicant's arguments are not deemed persuasive. Applicant's amendment to the claims was entered because there was no new matter or search required, the amounts 30-90mg were already present in other dependent claims and had already been addressed. The position of the office remains the same, that the rejection of claims 1-2, 4-5, 9 and 12-20 over Haul et al. in view of Dinnebie et al. in further view of Vippagunta et al. is proper and is maintained.

For completeness of the record, Applicant's arguments that they would file a terminal disclaimer when the instant claims are found to be allowable and the applicant determine that Donsbach et al. poses a double patenting issue for the allowed claims is acknowledged. However, until the claims are found allowable or the examiner deems the claims no longer read on those of Donsbach et al. the double patenting rejection is maintained.

Applicant has argued that they have amended the claims and that they render the examiner's rejection of claims 1-2, 4-5, 9, and 12-20 over Haul et al. in view of Dinnebie et al. in further view of Vippagunta et al. moot. This argument is not found persuasive as applicant's argument appears to be that the prior art does not teach amounts and the claims now recite 30-90mg of telmisartan sodium. Dependent claims previously had both 30mg and 90mg as lower and upper limits and it was already previously shown that Haul et al. teaches 50 and 100mg of the telmisartan (column 133, examples 230 and 232 - discussed on page 12 of the non-final office action dated July 30, 2009) which read upon applicant's claimed ranges. Furthermore, applicant's argument that Haul et al. is irrelevant because they teach an oral suspension is strongly disagreed with again, as it was in the final office action. Haul et al. teaches capsules in both examples 230 and 232 and that reads upon applicant's claims directly. Merely because they also teach an oral suspension does not make the reference irrelevant. Further, if the oral suspension was encapsulated it would still read upon the claims. Applicant's arguments were carefully considered but are not deemed to be persuasive for both the reasons above and those already addressed in the final rejection dated April 23, 2010 of which the reasons are incorporated by reference.

In absence of any additional arguments or remarks regarding the patentability of the claims pending at the time of the final rejection, the claims remain rejected for the reasons of record previously set forth in the final rejection of April 23, 2010.